

## **REMARKS/ARGUMENTS**

### **Status of the Claims**

In the Office Action mailed September 22, 2005, claims 1-13 are pending. Claims 1-13 were rejected, which is respectfully traversed as detailed below. In the current response, claims 1-13 have been amended and new claims 14-20 have been added. As a result claims 1-20 are pending. Applicants have thoroughly reviewed the outstanding Office Action including the Examiner's remarks and the references cited therein. No new matter has been added. The following remarks are believed to be fully responsive to the Office Action. All the pending claims at issue are believed to be patentable over the cited references. Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

### **Claim Rejections – 35. U.S.C. §102**

#### **Claims 1-6**

The Examiner rejected claims 1-6 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 863,009 to Supper. Without conceding the propriety of the rejections, claim 1 has been amended. Support for the amendment is to be found at least on page 4 of the specification and in the Figures. No new matter has been added.

For anticipation under 35 U.S.C. §102 the reference must teach every aspect of the claimed invention either explicitly or implicitly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02).

Supper cannot teach or suggest, at least, *inter alia*, “a plurality of superposed specimen storage spaces. . . the superposed specimen storage spaces are configured to be individually and

independently controlled,” as recited in claim 1. Rather, Supper is directed to a churn having U-shaped receptacles. (Col. 1, lines 10-16). Cream is added to the receptacles and a cover is then placed on the receptacle. (Col. 1, lines 43-56). The receptacles are suspended on a wheel frame and then rotated. (Col. 2, lines 84-94). However, an individual receptacle cannot be independently or individually controlled as currently claimed because all the receptacles of Supper are rotated together. Further, the receptacles are not superposed as is currently claimed.

Since each and every element, as set forth in the claim, is not found, either expressly or inherently described as required by the M.P.E.P. Supper cannot be said to anticipate, “a plurality of superposed specimen storage spaces. . . the superposed specimen storage spaces are configured to be individually and independently controlled,” as recited in claim 1. Accordingly, withdrawal of the rejection is respectfully requested.

Claims 2-6 depend from independent claim 1. Because claim 1 is believed to be in condition for allowance, claims 2-6 are also believed to be in condition for allowance, at least by reason of their dependency. Accordingly, withdrawal of the rejection is respectfully requested.

#### Claims 1-13

The Examiner rejected claims 1-13 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,808,304 to Gebrain, *et al.* (hereinafter referred to as “Gebrain”). Without conceding the propriety of the rejections, claim 1 has been amended.

For anticipation under 35 U.S.C. §102 the reference must teach every aspect of the claimed invention either explicitly or implicitly. Any feature not directly taught must be inherently present (M.P.E.P. 706.02).

Gebrain cannot teach or suggest, at least, *inter alia*, “a plurality of superposed specimen storage spaces. . . the superposed specimen storage spaces are configured to be individually and independently controlled,” as recited in claim 1. Rather, Gebrain is directed to methods for causing a vortex-like mixing action in a liquid-filled container by moving the container in a sinusoidal fashion at high speeds. (Summary). In particular, Gebrain discloses a reaction carousel that is rotatable using stepwise movements. (Col. 3, lines 30-49). Further, a clinical analyzer near the carousel contains several assay operation devices. (Col. 4, lines 4-14). However, these are placed about the carousel’s perimeter, on the same plane as the carousel, and are not vertically stacked or “superposed” in an incubator.

Within a vessel array storage unit, vessel arrays are arranged in a vertical manner. (Col. 7, lines 22-44). However, the vessel arrays are merely stored in this manner and are not shaken in the vessel array storage unit. (Id.) A shaking movement of the vessel array only occurs along the tracks arranged perpendicular to the vessel array storage unit. (Id.) Further, Gebrain discloses a vertically translatable assay elevator. (Id.) However, this elevator also does not shake its contents and merely facilitates transferring vessels onto the sampling tracks.

Since each and every element, as set forth in the claim, is not found, either expressly or inherently described as required by the M.P.E.P. Gebrain cannot be said to anticipate, “a plurality of superposed specimen storage spaces. . . the superposed specimen storage spaces are configured to be individually and independently controlled,” as recited in claim 1. Accordingly, withdrawal of the rejection is respectfully requested.

Claim 12 has been amended to recite structural language, removing the objectionable functional language.

Claims 2-13 depend from independent claim 1. Because claim 1 is believed to be in condition for allowance, claims 2-13 are also believed to be in condition for allowance, at least by reason of their dependency. Accordingly, withdrawal of the rejection is respectfully requested.

**Claim Rejections 35 U.S.C. §103(a)**

Examiner rejected claims 1-13 under 35 U.S.C. §103(a) as being unpatentable over U.S. 2003/0215357 to Malterer, *et al.* (hereinafter referred to as “Malterer”) in view of U.S. Patent No. 5,346,303 to Heinonen. This rejection is respectfully traversed. Claim 1 has been amended.

The Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. *MPEP*§2142. To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation to modify the references or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art must teach all the claim limitations. *MPEP*§2142. In light of the following arguments, the combined references do not teach or suggest all of the claim limitations of the present invention. Applicants respectfully point to the final prong of the test which states that the prior art must teach all of the claim limitations. At the very least, the combined references do not teach or suggest all of the limitations of these claims, as stated below.

Malterer does not teach or suggest, at least, *inter alia*, “a plurality of superposed specimen storage spaces. . . the superposed specimen storage spaces are configured to be individually and independently controlled,” as recited in claim 1. Rather, Malterer is directed to an automated processing system that is modular and can be combined in various ways. (Para. 11). The system has a plurality of shelf modules in a vertical arrangement, where a shelf module

comprises a robot arm, transfer facilitator, a stack, a carousel or the like. (Paras. 15-16).

Generally, the systems, methods and devices are used to transfer physical objects between a variety of mechanisms that are capable of manipulating the objects. (Para 36). Such mechanisms, for manipulating the objects, including a shaker, may be placed on the modular shelves. (Para. 87).

However, Malterer is not directed to a shaker and the particular aspects of a shaker. Further, the storage rack itself is not designed to shake an object or specimen. Therefore, Malterer does not disclose, “a plurality of superposed specimen storage spaces. . . the superposed specimen storage spaces are configured to be individually and independently controlled,” as recited claim 1. Malterer merely discloses vertically aligned shelves.

Heinonen does not cure the insufficiencies of Malterer. Rather, Heinonen is directed to an incubator comprising an even number of shaking planes placed above one another. (Col. 1, lines 34-40). The shaking planes are connected to each other by means of three vertical shafts. (Col. 1, lines 46-54). Turning one of the shafts causes a simultaneous rotation of the other shafts. (Col. 2, lines 45-63). “Therefore, each point of the plate 11 is in a similar shaking motion.” (Id.) Thus, an individual and independent shaking of one plane, while keeping the other planes static, is not possible. Therefore, Heinonen and Malterer, alone or in combination, do not disclose, “a plurality of superposed specimen storage spaces. . . the superposed specimen storage spaces are configured to be individually and independently controlled,” as recited claim 1.

New Claims 14-20

New claims 14-20 have been added. These claims are believed to be allowable over the cited prior art as discussed herein. Supper discloses U-shaped receptacles placed on a wheel. Gebrain is directed to methods for causing a vortex-like mixing action in a liquid-filled container by moving the container in a sinusoidal fashion at high speeds and does not disclose a shaking unit having the configuration of claim 14. Malterer is not directed to a shaking unit, but rather to an arrangement of modularized shelves. Heinonen discloses a shaking unit having planes that are coupled by rotating shafts.

Therefore, none of the cited prior art disclose, “a base; a shaking platform coupled to the base; a spacer disposed above the shaking platform; a clamping element disposed above the spacer; and a specimen storage unit disposed above the clamping element, wherein the specimen storage unit is configured to house at least a plurality of specimens,” as recited in claim 14. Claims 15-20 depend from independent claim 14. Because claim 14 is believed to be in condition for allowance, claims 15-20 are also believed to be in condition for allowance.

**CONCLUSION**

In view of the foregoing remarks, Applicants respectfully submit that this application is in condition for allowance. Should the Examiner believe that anything further is necessary to place the application in even better condition for allowance, the Examiner is invited to contact the undersigned attorney at 202-861-1746 in an effort to resolve any matter still outstanding before issuing another action.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiencies or credit any overpayments to Deposit Account No. 50-2036 with reference to our Docket No. 87333.3301.

Respectfully submitted,

BAKER & HOSTETLER LLP



Rabiya S. Kader  
Reg. No. 48,160

Date: January 23, 2006  
Washington Square, Suite 1100  
1050 Connecticut Avenue, N.W.  
Washington, D.C. 20036-5304  
Telephone: 202-861-1500  
Facsimile: 202-861-1783